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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KOJI IDEI  
and YOSHIHIKO HIBINO

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Appeal 2008-3015  
Application 09/508,617  
Technology Center 1700

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Decided: May 28, 2008

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Before CHUNG K. PAK, PETER F. KRATZ, and ROMULO H.  
DELMENDO, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's final rejection of claims 1 and 3-7. We have jurisdiction pursuant to 35 U.S.C. § 6.

Appellants' invention is directed to a paper comprising, *inter alia*, a support having a cationic resin present on a surface thereof and adhered thereto in a specified amount. Claim 1 is illustrative and is reproduced below:

1. A paper for ink jet and electrophotographic recording which comprises a support having a cationic resin present on a surface of the support, the cationic resin adhered thereto in a dry adhering amount of 0.5-2.0 g/m<sup>2</sup> and which has a surface resistivity of  $1.0 \times 10^9 - 9.9 \times 10^{13} \Omega$ , wherein the cationic resin has a cation equivalent of 3-8 meq/g as measured by colloidal titration method.

The Examiner relies on the following prior art references as evidence in rejecting the appealed claims:

Shepherd	4,207,142	Jun. 10, 1980
Fujioka	4,279,961	Jul. 21, 1981

Claims 1 and 5-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Fujioka. Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fujioka in view of Shepherd.<sup>1</sup>

We affirm both of the Examiner's maintained rejections.

*§ 102(b) Rejection over Fujioka*

Appellants argue the rejected claims together as a group. Accordingly, we select claim 1 as the representative claim on which we decide this appeal as to this rejection.

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<sup>1</sup> A rejection of claims 1 and 3-7 under 35 U.S.C. § 112, first paragraph and a rejection of the same claims under 35 U.S.C. § 102 over Asano (U.S. Patent No. 6,335,085), as set forth in the Final Office Action mailed September 08, 2006, were withdrawn by the Examiner (Ans. 6 and 9).

“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *accord Glaxo, Inc. v. Novopharm, Ltd.*, 52 F.3d 1043, 1047 (Fed. Cir. 1995). However, anticipation by a prior art reference does not require that the reference recognize either the inventive concept of the claimed subject matter or the inherent properties that may be possessed by the prior art reference. *See Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 633 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

Anticipation under this section is a factual determination. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991) (citing *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990). However, arguments not made in the Briefs are waived. *See* 37 C.F.R. § 41.37(c)(vii) (2006).

The Examiner has found that the cationic resin coated substrate of Fujioka includes surface resistivity corresponding to that called for in representative claim 1 (Ans. 3). Also, the Examiner has found that the cationic resin employed by Fujioka would have been expected to possess a cation equivalent property, as here-claimed, given the correspondence in resins and amounts thereof employed (Ans. 4-5).

Appellants do not contend that the claimed amount of cationic resin differs from the amount of cationic resin added to the coating composition of Fujioka, as an electro-conductive layer, to a paper base sheet. Also, Appellants do not argue that the surface resistivity and/or the cation equivalent property of the resin, as required by representative claim 1, lack correspondence with or differ from such properties as would be explicitly or

implicitly associated with the cationic resin containing electro-conductive layer surface of Fujioka. Rather, Appellants argue that:

... the final product disclosed in **Fujioki et al.**, which is to be compared with the present invention, is constituted of a paper substrate, an electroconductive [sic] layer and a record forming layer formed on the electroconductive [sic] layer. In **Fujioka et al.**, a cationic resin is contained only in the electroconductive [sic] layer, and the record forming layer is mainly composed of an insulative resin. A cationic resin is not present on the surface of the recording layer. Moreover, **Fujioka et al.** fails to disclose or suggest that the surface resistivity of the recording side of the paper is  $1.0 \times 10^9 - 9.9 \times 10^{13} \Omega$ , as claimed in the present invention. There is no motivation in **Fujioka et al.** to lead one of ordinary skill in the art to the present invention with the other respects.

*Br. 10 (emphasis in original)*

Also, Appellants maintain that:

... claim 1 on appeal recites that a cationic resin is present on a surface of the support, which does not limit the presence of the resin to only the surface of the recording side, but permits the cationic resin to be present on both surfaces. In **Fujioka et al.**, the cationic resin is not present on either surface of the paper.

*Br. 11 (emphasis in original)*

In this regard, Appellants basically acknowledge that Fujioka includes a cationic resin layer (electro-conductive layer) on a paper substrate. However, Appellants note that Fujioka does not disclose that the record forming layer itself, which is formed on the electro-conductive layer of Fujioka, has a cationic resin on the record forming layer surface with the

surface resistivity property of the recording layer surface corresponding with the representative claim 1 resistivity.

This argument is not persuasive because representative claim 1 requires that the cationic resin is present on a support surface and employs open “comprising” language that does not preclude the claimed product from having another layer placed onto the cationic resin coated support surface thereof, such as a layer like the insulative resin-containing record forming layer of Fujioka. Moreover, assuming *arguendo*, that representative claim 1 excluded another layer being placed onto the cationic resin coated substrate surface, we observe that the intermediate product of Fujioka - that is, the product of Fujioka prior to the inclusion of a record forming layer thereon - would represent a product with a cationic resin coated substrate surface, which intermediate product Appellants have not shown to be distinct from the representative claim 1 cationic resin coated substrate.

It follows that, on this record, we affirm the Examiner’s anticipation rejection.

*§ 103(a) Rejection over Fujioka and Shepherd*

Concerning the separate obviousness rejection of dependent claims 3 and 4, Appellants do not contest the Examiner’s additional reliance on Shepherd for establishing the obviousness of employing a sizing agent as recited in dependent claim 3 or using a waste paper pulp in forming the coated substrate of Fujioka. Rather, Appellants focus on the same argument made for the patentability of independent claim 1 in arguing for the patentability of these dependent claims.

As we explained above with respect to the Examiner's separate rejection of claim 1, such argument is not persuasive of a patentable distinction over the teachings of Fujioka alone, much less when taken in combination with Shepard. Accordingly, we shall also affirm the Examiner's obviousness rejection of claims 3 and 4, on this record.

#### CONCLUSION

The decision of the Examiner to reject claims 1 and 5-7 under 35 U.S.C. § 102(b) as being anticipated by Fujioka and to reject claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Fujioka in view of Shepherd is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2006).

AFFIRMED

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